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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alexandria Real Estate Equities

Serial No. 75982917

Susan D. Berney-Key and Mary C. O'Connor of Cooley Godward
LLP for Alexandria Real Estate Equities.

Carolyn Pendleton Cataldo, Trademark Examining Attorney,
Law Office 103 (Michael Hamilton, Managing Attorney).

Before Bucher, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Alexandria Real Estate Equities seeks registration on
the Principal Register of the mark LABSPACE for services
recited in the application, as amended, as follows:

"Business consulting services; business
incubator services, namely business
management and business development services
in the form of start-up support for
businesses of others; rental and leasing of
office machinery and equipment," in
International Class 35;

"Investment brokerage, consultation, and
management; financial portfolio management;
financial services, namely financial
consultation, financial analysis, financial

planning, financial management, financial portfolio management, financing services, and providing debt and equity capital; incubator financing services," in International Class 36; and

"Rental and leasing of computers," in International Class 42.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that this term is merely descriptive of the recited services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

¹ Application Serial No. 76187873 was filed on December 29, 2000 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. At applicant's request, that application was divided in August 2002. On March 8, 2003, an amendment alleging use at least as early as May 13, 1999 (for the services that remained in the parent application) was filed. Then, on December 30, 2003, the parent application resulted in issuance of Reg. No. 2801541 on the Supplemental Register, for services recited as follows:

"Operation of businesses for others, namely life science research; business management," in International Class 35;

"Real estate services, namely, real estate brokerage, leasing and management services; land acquisition, namely real estate brokerage services; rental of real estate, namely rental of commercial, manufacturing, and research and development space, leasing of real property," in International Class 36;

"Real estate development services; building construction and repair services; maintenance and/or repair of buildings, electrical systems, heating and air conditioning systems, and plumbing systems," in International Class 37;

"Rental of warehouse space," in International Class 39; and

"Architectural design services; engineering services," in International Class 42.

Applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing.

We affirm the refusal to register as to the services in International Class 35 but reverse the refusals to register as to the services in International Classes 36 and 42, as discussed below.

A term is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. A term is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a particular term is merely descriptive is not decided in the abstract. Rather, the proper test in determining whether a term is merely descriptive is to consider the term in relation to the

goods or services for which registration is sought, the context in which the term is used or is intended to be used, and the significance that the term is likely to have on the average purchaser encountering the goods or services in the marketplace. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

The Trademark Examining Attorney argues that this proposed mark is merely descriptive because it describes a significant function, purpose or characteristic of applicant's services. She argues that the word "lab" has been shown to be a shortened version of the word "laboratory," and that the evidence of record demonstrates that the wording "lab space" is recognized as referring to space in buildings used for laboratory purposes.

By contrast, applicant argues that the articles placed into the record by the Trademark Examining Attorney refer to "lab space" and "laboratory space" as physical locations and buildings; that the evidence does not tie the wording

"lab space" to offering of "critical" services, and does not show use of the mark to describe the types of services involved herein; that a "consumer would have to use ... imagination to make the leap ... to ascertain the nature of the services that are actually offered in the present application"; that none of the articles use "labspace" as a single word; and that the Trademark Examining Attorney has failed to demonstrate a single instance of competitors' use of the wording "labspace."² Applicant has also argued that its mark does not indicate that the services provided in connection with the mark are financial, incubation and consulting services, and that "the mark does not describe these services with any degree of particularity."

Among the evidence in the record are the following excerpts from the LEXIS/NEXIS database of news articles:

"...the General Services Administration ... sought \$92 million in funding to build the project's second phase, and \$9 million to design the third phase, office and **lab space** for the Center for Devices and Radiological Health";³

"CNI has about 10 employees now and has taken office and **lab space** near Interstate 10 and Texas 6";⁴

² In our analysis of whether the applied-for term is merely descriptive, it is certainly immaterial that none of the articles uses "labspace" as a single word.

³ The Washington Times, April 16, 2001.

⁴ The Houston Chronicle, April 12, 2001.

"To expand research, for example, it needs **lab space** that it doesn't have...";⁵

"The company is eying the Piedmont Triad Research Park in downtown Winston-Salem because it offers **incubator lab space** that is not available in Greensboro...";⁶

"What we lack is affordable commercial **lab space**, which means that companies out of the **incubator stage** have to look elsewhere for space to expand";⁷

"The two-story building will have offices, **lab space** and training rooms";⁸

"The expansion nearly doubles the space in the building, providing seven full-size, state of the art teaching laboratories - compared with three before the construction. It also provides additional research **lab space**, including one lab just for students...";⁹

"In addition to **lab space**, the Bender Laboratory also would house **incubator** space for drug discovery enterprises...";¹⁰

"Scientific Properties is actively pursuing other development opportunities, and Rothschild would love to create more **lab space** ...";¹¹

"... Phase 3 Properties, a firm that specializes in building biotech **lab space**";¹²

"The company settled into new **lab space** at the Karmanos Cancer Institute at Wayne State University. 'We do see (laboratory and **incubator space**) as an issue that needs to be addressed...'";¹³

⁵ Pittsburgh Post-Gazette, April 12, 2001.

⁶ News & Record, April 5, 2001.

⁷ Crain's New York Business, April 2, 2001.

⁸ The Houston Chronicle, April 1, 2001.

⁹ The Courier-Journal, March 29, 2001.

¹⁰ The Times Union, January 31, 2002.

¹¹ The Herald-Sun, January 24, 2002).

¹² The San Diego Union-Tribune, January 18, 2002.

¹³ Crain's Detroit Business, January 7, 2002. We note that start-up businesses in basic life science research, drug production, cellular therapy and drug discovery use the word

"The company moved into its current facility in November 2000 after it outgrew its **lab space** at the Maryland Technology Development Center, a Rockville business **incubator**".¹⁴

The Trademark Examining Attorney demonstrated from a newspaper article drawn from the Internet that applicant specializes in acquiring laboratory facilities for lease:

TITLE: "**Subleasing helps solve lab space shortage**",

...

"How is the growing Seattle biotechnology community coping with the lack of laboratory space in the area? Everyone from start-up biotech companies to established research centers are looking for alternative solutions.

Most new business enterprises can lease office or warehouse space and be relatively flexible in meeting their specific space needs. Start-up biotechnology companies must either spend significant amounts of their coveted capital to construct laboratory facilities or compete with well financed, growing organizations like the University of Washington or Immunex Corp. for what little laboratory space becomes available.

However, there is virtually no vacant, high quality laboratory space available right now.

Two recently purchased facilities and one facility currently under construction are

"incubator" in two different contexts. The first one is seen in applicant's recital of services. International Class 35 refers to "business incubator services." These incubator services include development and support for small biotech firms. The second meaning of incubator is seen in this particular excerpt, where it appears to be a term of art for a controlled environment for growing cultures, etc.

¹⁴ The Washington Post, December 17, 2001.

the only near-term options: ***Alexandria Real Estate Equities***, a real estate investment trust (REIT) ***specializing in acquiring laboratory facilities for lease***, purchased the former Fred Hutchinson Cancer Research's building on First Hill in 1996 and recently acquired Bristol-Myers Squibb's former research buildings in Seattle. The Virginia Mason Research Center is in the midst of constructing a new state-of-the-art laboratory facility at 9th and Seneca, known as the Benaroya Research Center at Virginia Mason.

All three buildings ***are currently marketing laboratory space for lease in the near future***; however, the space is not currently available ...¹⁵

The Trademark Examining Attorney argues from this evidence that applicant's services specifically relate to providing business, equipment and financing support to firms seeking to acquire "laboratory space," or simply "lab space." She argues that while the term "lab space" indeed describes a physical location, this is exactly the focus of, or purpose for, applicant's business and financial services. That is, applicant's services enable start-up companies to obtain *lab space*.

On the other hand, as argued by applicant, the NEXIS evidence quoted above uses the term "lab space" to refer specifically to physical space, and not directly to any

¹⁵ *The Seattle Daily Journal of Commerce*, March 12, 1998, www.djc.com/special/cmarket98/10036754.htm

kind of services. Yet we agree with the Trademark Examining Attorney that the word "lab" is clearly a shortened version of the word "laboratory," and the record shows that the wording "lab space" refers to space in buildings used for laboratory purposes.

Accordingly, when used in connection with applicant's services of acquiring laboratory facilities for lease (i.e., the bundle of services recited in the "parent" application), the term LABSPACE was appropriately placed on the Supplemental Register [See Reg. No. 2801541, footnote 1, *supra*].

In the instant appeal, however, we have some doubt as to whether the term LABSPACE is merely descriptive for the ancillary services in at least two of the International Classes divided out for this "child" application - namely, applicant's generalized financial services in International Class 36 and applicant's computer rental services in International Class 42. Nothing in the recitation of services or in the NEXIS evidence points to unique financial services in this context or to computer rentals that are specifically designed for laboratory spaces. Moreover, even if there were a category of services known as "lab" computer rentals, for example, the addition of the

term "space" would appear to make the composite mark into a suggestive term when used in connection with these computer rental services.

As to the business incubator services in International Class 35, however, we are compelled to examine more closely the specific evidence that the Trademark Examining Attorney has placed into the record.

Applicant's business incubator services in the form of start-up support would include start-up support for biotechnology companies needing laboratory space. Some of the articles indicate that lab space is a serious problem for these types of companies:

- *"it needs lab space that it doesn't have"*
- *"What we lack is affordable commercial lab space, which means that companies out of the incubator stage have to look elsewhere for space to expand";*
- *"...We do see (laboratory and incubator space) as an issue that needs to be addressed..."*
- *"Subleasing helps solve lab space shortage"*

Applicant provides exactly this type of service

("... specializing in acquiring laboratory facilities for lease ..."). When prospective purchasers see the term LABSPACE in association with business incubator services in the form of support for start-up biotech companies, they will immediately understand that applicant's services

include services involving business development services that assist start-up laboratories and research businesses in overcoming their challenging needs for lab space.

As the Board said in In re Analog Devices, Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd in a decision marked non-citable as precedent, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989), "it is a well settled legal principle that where a mark may be merely descriptive of one or more items of goods [or services] in an application but may be suggestive or even arbitrary as applied to other items, registration is properly refused if the subject matter for registration is descriptive of any of the goods [or services] for which registration is sought." Accordingly, having determined that the mark LABSPACE is merely descriptive as to "business incubator services," the refusal to register as to all of the services in International Class 35 must be affirmed.

Decision: The refusals to register as to the services in International Classes 36 and 42 are reversed, but the refusal to register as to the services in International Class 35 is hereby affirmed.